

REMARKS

I. Status of the Application.

Claims 1-19 were filed with this application. In a non-final office action dated July 24, 2008, Examiner Greece (a) rejected claims 1-8 under 35 U.S.C. 102 as being obvious over U.S. Patent Publication 2004/0054358 to Cox et al. (the "Cox Reference"); (b) rejected claims 9-19 as being unpatentable over the Cox Reference in further light of U.S. Patent 5,777,719 to Williams et al. (the "Williams Patent"); and (c) rejected claims 8 and 15 for lack of antecedent basis. In this response, Applicants (a) submit amendments to claims 1 and 9, (b) add new claims 20-24, and (c) respectfully traverse the examiner's rejections.

II. Overview of the Cox Reference and the Williams Patent

Both the Cox Reference and the Williams Patent disclose a method for which aberration data is collected and then used to provide a higher order aberration correction for the eye. (Williams Patent, Col. 2, lns. 43-45, "a primary object of the present invention to provide a method of and an apparatus for accurately measuring higher order aberrations of the eye and for using the data thus measured to compensate for those aberrations with a customized optical element;" Cox Reference, para 0043, "a customized LASIK treatment to correct lower-order and higher-order aberrations that cause vision defects in the patients eye 120, or a custom treatment for a decentered ablation will apply to PRK and LASEK, for example, as well as to the design and performance of custom ophthalmic optics including contact lenses, IOL's, inlays, and onlays.") As such, the Williams Patent and Cox Reference employ new refractive surgery and lens fabrication methods to develop lenses and corneas that will correct other than the typical lower order spherocylinder errors, contrary to the claimed method. Therefore, the cited

references do not disclose a method for optimizing a low order correction for spherocylindrical prescriptions that eliminates the need for subjective refractions.

Additionally, neither the Cox Reference nor the Williams Patent eliminate the need for subjective refractions to conduct low order optimizations. In particular, the Cox Reference admits that "the practitioner may want to optimize post-surgical spherical (and other) aberration," indicating that low order aberration correction is not optimized through the method. *Id.* Further, the Cox Reference employs subjective refractions, a process that is eliminated through the use of the method claimed herein. *Id.* (para 120, "The information [from the diagnostic system] is still further modified at 259 by personalized surgeon monogram 260.").

IV. Claims 1-8 As Amended are Not Anticipated by the Cox Reference

A. Standard for Anticipation

In order to establish that the claims are anticipated by the Cox Reference, the reference must teach every element of the claim. MPEP § 2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Indeed, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." MPEP 2131, *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989), emphasis added. Therefore, without enabling disclosure of each and every element or limitation of a claim, a prima facie case of anticipation cannot be made against a claim.

B. The Cox Reference does not include an "Equivalent Quadratic Fitting Calculation"

Claim 1 of the pending Application requires "perform[ing] an equivalent quadratic fitting calculation to obtain at least one clinical refractive prescription," which is not present in the Cox Reference. The Office Action points to paragraph [0043] of the Cox Reference as teaching this limitation, but upon inspection, no mention of an equivalent quadratic fitting calculation is present in paragraph [0043] or in the remainder of the Cox Reference. Office Action, page 2. Additionally, the Office Action notes that a "second order Zernike is easily converted to spherocylindrical prescription." *Id.* Applicants respectfully point out that a straight conversion of the second order Zernike does not generate an optimized spherocylindrical prescription as required by claim 1. Further, the optimization step of claim 1 requires an equivalent quadratic fitting calculation, which the simple conversion of the second order Zernike does not satisfy. Therefore, since at least the equivalent quadratic fitting and optimization are not taught by the Cox Reference, the Cox reference does not anticipate Claim 1 or any of the claims which depend on claim 1.

Further, the claims are drawn to "A method for optimizing a refractive prescription without using subjective refractions," and include the limitation that employs "the equivalent quadratic fitting calculation that optimizes the quality of the retinal image to obtain at least one clinical refractive prescription" The method taught in the Cox reference does not disclose optimizing lower order prescriptions without the use of subjective refractions and does not optimize the quality of the retinal image as claimed. Therefore, since each and every claim element is not expressly or inherently described in the Cox Reference, it does not anticipate claim 1. Accordingly, Applicants respectfully request reconsideration and allowance of claim 1 as amended. Further, since claims 2-8, and 20-21 depend from claim 1, allowance of those claims is respectfully requested.

V. Claims 9-19 are Not Obvious in Light of the Cox Reference or the Williams Patent

MPEP § 2142 states that "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." A *prima facie* case of obviousness requires that "an apparent reason to combine the known elements in the fashion claimed . . . should be made explicit," a reasonable likelihood of success in modifying the prior art, and the cited references must contain all of the limitations of the claims. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1741 (2007); MPEP §2143. Therefore, in order for references to render the claims obvious, (1) the cited references must include each and every limitation within the claim cited; (2) the examiner must explicitly point to a particular reason to combine or modify the one or more references; and (3) there must be a reasonable basis to believe that the modifications or combination of the cited references would be successful. For the reasons cited below, Applicants respectfully submit that the amended claims are not subject to a *prima facie* conclusion of obviousness.

Claim 9 is directed to "A method for optimizing a refractive prescription without using subjective refractions." Neither the Cox Reference nor the Williams Patent disclose or suggest optimizing lower order prescriptions without the use of subjective refractions nor would one skilled in the art infer the same from these references alone or in combination. Accordingly, the references do not render claim 9 obvious. Further, since claims 9-19 and 22-24 depend from claim 9 they are not rendered obvious either, Applicants respectfully request allowance of those claims as well.

Commissioner for Patents
Serial No. 10/582,470
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Reply to Office Action dated July 2, 2009

VI. New Claims 20-24 are Added Herein.

Applicants respectfully submit new claims 20-24 herein to further define the invention. Claims 20-24 do not constitute new matter and are supported generally by the Application as originally filed. Support for the limitations to claims 20-23 can be found on page 30, lines 14-16 of the Application as filed. Further, support for the limitations of claim 24 can be found on pages 11-28 of the Application as filed. Accordingly, Applicants respectfully request entry and acceptance of these claim amendments.

VII. The Finality of the Office Action Should be Withdrawn.

Since the application is now believed to be in condition for allowance, the Examiner is urged to enter the above amendments to preclude further protracted prosecution.

CONCLUSION

For all the foregoing reasons, it is respectfully submitted that Applicants have made a patentable contribution to the art and that this response places all of the pending claims of the above identified application in condition for allowance. Favorable reconsideration and allowance of this application is respectfully requested. Should the Examiner find that Applicants arguments do not overcome the rejections of the Office Action, a request for the withdrawal of Finality as detailed in Section VII is requested and Examiner is invited to contact the undersigned to resolve any remaining disputed issues.

Applicants herewith submit payment of fees in the amount of one hundred and four dollars (\$104) for the introduction of four (4) new claims in excess of 20 claims under 37 CFR 1.16(i). In the event that Applicants have inadvertently overlooked the need for an extension of time or payment of an additional fee, Applicants conditionally petition therefore, and authorize any fee deficiency to be charged to deposit account 09-0007. Please refer to File No. P00873-US-01 (16584.0023) when making a charge or credit against the deposit account.

Sincerely,

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